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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No.

HYMIE D. GESSER AND ROBERT E. WARRINER,
Petitioners,

vs.

C. MARSHALL DANN, COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MUNSON H. LANE,
Munsey Building,
Washington, D. C. 20004,
Counsel for Petitioner.

MERRIAM, MARSHALL, SHAPIRO
& KLOSE,
Two First National Plaza,
Chicago, Illinois 60670,

HOWARD HERMANN,
Midland, Michigan 48640,
Of Counsel.

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Petitioners, Hymie D. Gesser and Robert E. Warriner, pray that a writ of certiorari issue to review those portions of the judgment of the United States Court of Customs and Patent Appeals (CCPA) entered March 21, 1974, which affirmed the decision of the United States Patent Office Board of Appeals rejecting all of the claims on appeal as being obvious under 35 U. S. C. 103 of the Patent Laws.

OPINIONS BELOW.

A. The unreported decision of the Patent Office Primary Examiner finally rejecting all of the claims in the case is reproduced in Appendix A, infra, page A1.

B. The opinion of the United States Patent Office Board of Appeals is not reported and is reproduced in Appendix B, infra, page A2.

C. The opinion of the CCPA is unreported and is reproduced in Appendix C, infra, page A5.

JURISDICTION.

The jurisdiction of this Court is invoked under 28 U. S. C. § 1256. The judgment of the CCPA was entered on March 21, 1974; no petition for rehearing was made.

QUESTIONS PRESENTED.

1. In determining obviousness of an invention, pursuant to *Graham* v. *John Deere,* 383 U. S. 1, 18 (1966), may the Patent Office and its appellate tribunals ignore one of the three basic steps required by this Court, *viz.,* the determination of the level of ordinary skill in the art?

2. In combining references to reject claims as being obvious under 35 U. S. C. § 103 what is the extent of the disclosure required in the primary reference which will make it obvious to the worker of ordinary skill in the art to use the secondary references to modify the primary reference and produce the invention disclosed by applicant?

CONSTITUTION AND STATUTORY PROVISIONS INVOLVED.

Art. 1, Sec. 8, Clause 8 of the Constitution of the Constitution of the United States provides:

> "The Congress shall have power . . . To promote the Progress of Science and useful Arts, by securing for limited Time to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

Title 35, United States Code, section 103 provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE.

A. The Invention:

The invention relates to a process for the treatment of plastic contact lenses by exposing their surfaces to *attack* by polar-functional-group-forming radicals, thereby replacing part of the surface hydrophobic groups with polar hydrophilic functional groups, thus increasing the wettability of the surface.

According to appellant's process, the lens itself is treated in such a manner as to cause hydrophilic groups, provided by compounds which are added to the process, "to *interact* with the surface of the lens," to which surface they are attached with a *permanent* bond."

The interaction is effected by exposing the lens and the added compound to attack, preferably using radiant energy phenomena such as an electrical discharge, radiolysis in the gas phase, photolysis, microwave discharge, and radio frequency discharge.

B. Proceedings Below:

1. Before the Patent Office Primary Examiner.

The application at bar, filed April 17, 1970, is a continuation-in-part of an earlier application filed April 19, 1965. The initial Office Action on this application, entered January 25, 1971, was a final rejection of all claims on the grounds that they were obvious under 35 U. S. C. 103 in view of the following references:

Szekeley et al. U. S. Patent 3,183,152
Ambroski U. S. Patent 3,274,090
Ambroski U. S. Patent 3,274,091

2. Before the Patent Office Board of Appeals.

The Board of Appeals on August 16, 1972, affirmed the decision of the Primary Examiner on the same grounds of obviousness.

3. In the Court of Customs and Patent Appeals.

The CCPA on March 21, 1974, affirmed the decision of the Board of Appeals, rejecting all of the claims as being obvious under 35 U. S. C. 103, using the same combination of references relied upon by the Primary Examiner and the Board of Appeals.

REASONS FOR GRANTING THE WRIT.

In each decision in the proceedings below, which are notable for their brevity, the various tribunals, although unanimous in rejecting the claims on appeal as obvious under 35 U. S. C. 103, patently failed to apply the test for obviousness which has been clearly established by this Court in *Graham* v. *John Deere*, 383 U. S. 1, 18 (1966). In accordance with the dictates of this Court, the test of obviousness under 35 U. S. C. 103 of the Patent Laws requires that: 1) The scope and content of the prior art be determined, 2) The differences between the prior art and the claims and issues be ascertained, and 3) The level of ordinary skill in the pertinent art be resolved. It is respectfully submitted that in none of the tribunals below was the issue of obviousness of the subject matter of the application at bar determined against this background, nor did the tribunals individually examine the claims to determine if each was obvious from the prior art.

The Primary Examiner summarily concluded (Appendix A) as follows:

"Claims 1-11 are rejected under 35 U. S. C. 103 as being obvious in view of Szekely et al. and the Amborski patents. It is evident that Szekely et al. is concerned with the problem of wettability of contact lenses along with non-irritating and non-sensitizing effect. The Amborski patents teach a method of improving wettability of polymeric materials by subjecting the surface of such materials to an electrical discharge in the presence of a gaseous atmosphere. Such atmosphere may be of a compound which produces radicals containing oxygen or nitrogen atoms, e.g. an amide such as formamide (claim 2 and page 4 of specification). It is to be noted that the Amborski patents disclose in col. 2, that the gaseous atmosphere consists essentially of the formamide as the "sole active agent."

The Board of Appeals concluded (Appendix B) as follows:

"In view of the above teachings, we disagree with the appellants' arguments and consider the references to be properly combinable since each attempts to overcome the same problem, which is the wettability of hydrophobic plastic surfaces. Whether in the form of a contact lens or a flat sheet (useful as wrapping material), each desires to overcome the fogging of a transparent plastic surface. Hence, the expedients taught in the Amborski patents are obviously applicable in the solving of the problem indicated in Szekely et al., which is fundamentally the same."

And finally, the CCPA stated (Appendix C) that:

"Appellants argue that Ambroski says nothing about contact lenses, or about the lens materials of claims 10 and 11. With such disclosures, Amborski would have been an anticipation. But Amborski is cited (with Szekely) under 35 U. S. C. 103 as rendering the claims obvious, not as an anticipation."

While it may be arguable that in each tribunal the scope and content of the prior art was determined and the differences between the prior art and the claims at issue ascertained, there was a failure by all the tribunals to determine what constituted

the level of ordinary skill in the pertinent art. It is recognized that this Court refused to grant certiorari in the *Trico Products Corp.* v. *Roberk Co.*, 490 F. 2d 1280, Supreme Court No. 73-1637 decided June 3, 1974, which petition was based upon the Second Circuit's refusal to determine the level of ordinary skill in the art in a patent case decided on summary judgment at the trial level. However, the establishment of criteria to determine this level becomes highly important in the evaluation of patentability at the Patent Office level wherein an invention is determined to be obvious under 35 U. S. C. 103, based upon a combination of references.

A dilemma occurs at the Patent Office level of application examination because the Examiners have a level of skill in a given art which is greater than that of the ordinary worker. This expertise is recognized by the Courts who generally defer to the Patent Office Examining Corps on technical issues in the particular art they examine: *Acme Highway Products Corp.* v. *D. S. Brown Co.*, 431 F. 2d 1074, 1081 (6th Cir., 1970), *Technicon Instruments Corporation* v. *Coleman Instruments Corporation*, 385 F. 2d 391, 393 (7th Cir. 1967), *Baldwin-Lima-Hamilton Corporation* v. *Tatnall Measuring Systems Company*, 169 F. Supp. 1 (E. D. Pa., 1958), aff'd., 268 F. 2d 395 (3d Cir. 1959); *Helms Products* v. *Lake Shore Manufacturing Company*, 227 F. 2d 677, 679 (7th Cir. 1955). This expertise gives rise to the undue application of hindsight reconstruction of the art, a practice which this Court has admonished against, *Graham* v. *Deere, supra,* and a minimizing of the real life, blood, sweat, and tears efforts of an inventor in making an invention.

Consideration of obviousness in the Patent Office as well as in appellate tribunals reviewing Patent Office decisions requires that the level of ordinary skill in the art be resolved. The basics of problem solving in making inventions must be taken into consideration and recognition given the fact that it is impractical to assume that the pertinent references spring full blown

before the inventor as if by magic like Athena from the brow of Jove.

This latter practice is seen in situations where in combining references the Examiners improperly use the applicant's own disclosure not only as part of the prior art (See *Application of Schaffer*, 229 F. 2d 476 (CCPA 1956), and *Application of Linnert*, 309 F. 2d 498 (CCPA 1962)), but also as the starting point for selecting references which do not fairly suggest doing what an applicant has done. See *In re Demarche*, 219 F. 2d 952 (CCPA, 1955). How this practice is improperly used is illustrated by the manner in which the CCPA applies the 103 obviousness test by first picturing the inventor as working in his shop with the prior art references—which he is presumed to know—hanging on the walls around him. See *In re Winslow*, 365 F. 2d 1017 (CCPA 1966).

This Court should establish criteria to be followed in resolving the level of ordinary skill to bridle the unfettered use of expertise of the Examiner and the improper use of applicant's own disclosure as part of the art's teachings in arriving at rejections based upon hindsight.

The problem of resolving the level of ordinary skill can be solved by this Court in instances, as in the case at bar, where obviousness is based upon the combining of references, by requiring that the disclosure in the primary reference be sufficiently pertinent and analogous as to provide the *basic structure* of applicant's invention, whether it be process, apparatus, or composition of matter, which can be *modified*, not reconstructed by hindsight, by the secondary references to produce applicants' invention.

CONCLUSION

This Court should grant certiorari to determine whether the Patent Office can apply the obviousness test under 35 USC 103 without a determination of the level of the skill in the art at the time of the invention, particularly in instances where a combination of references is relied upon in rejecting the invention as being obvious.

Respectfully submitted,

MUNSON H. LANE,
Munsey Building,
Washington, D. C. 20004,
Counsel for Petitioner.

MERRIAM, MARSHALL, SHAPIRO
& KLOSE,
Two First National Plaza,
Chicago, Illinois 60670,

HOWARD HERMANN,
Midland, Michigan 48640,
Of Counsel.

APPENDIX A.

FINAL REJECTION BY PATENT OFFICE

Claims 1-11 are rejected under 35 U. S. C. 103 as being obvious in view of Szekely et al and the Amborski patents. It is evident that Szekely et al is concerned with the problem of wettability of contact lenses along with non-irritating and non-sensitizing effect. The Amborski patents teach a method of improving wettability of polymeric materials by subjecting the surface of such materials to an electrical discharge in the presence of a gaseous atmosphere. Such atmosphere may be of a compound which produces radicals containing oxygen or nitrogen atoms, e.g. an amide such as foramide (claim 2 and page 4 of specification). It is to be noted that the Amborski patents disclose in col. 2, that the gaseous atmosphere consists essentially of the formamide as the "sole active agent".

It is therefore considered for one seeking to improve wettability of polymeric contact lenses to employ the technique of the Amborski patents, rejecting agents proving harmful to the eyes.

The claims and issue are basically the same as in the parent application and accordingly the rejection is made *FINAL.*
12/18/70

/s/ HOWARD S. WILLIAMS
Howard S. Williams
Examiner Group Art Unit 114

APPENDIX B.

OPINION AND DECISION OF BOARD OF APPEALS, AUGUST 16, 1972.

Before MAGIL and LIDOFF, *Examiners-in-Chief*, and MILESTONE, *Acting Examiner-in-Chief*.

LIDOFF, *Examiner-in-Chief*.

This is an appeal from the final rejection of claims 1 to 11, all the claims in this application, which are represented by:

> 1. A process for increasing the wettability of surfaces of optical plastic contact lenses consisting essentially of exposing the surface of said lenses to attack by polar-functional-group-forming radicals.

PATENT APPEAL No. 9170

The references relied on are:

Szekely et al.	3,183,152	May 11, 1965
Amborski	3,274,090	Sept. 20, 1966
Amborski	3,274,091	Sept. 20, 1966

The extensive reply brief is not limited to new arguments first presented in the very meager Examiner's Answer and hence is not entitled to consideration. See Rule 193(b).

Appellants' arguments, insofar as they are directed to the Examiner's Answer incorporating the final rejection in this application, have been carefully considered but do not persuade us of error in the Examiner's rejection of the appealed claims as unpatentable (35 U. S. C. 103) over Szekely et al. in view of the Amborski patents. We agree with the Examiner in his conclusion that the combination of these three patents renders obvious appellants' process as claimed.

Szekely et al. disclose the wettability problem in contact lenses, which appellants apparently admit to be known. This patent indicates that contact lenses made of hydrophobic plastic, such as methylmethacrylate, are subject to fogging of the surface due apparently to lack of wettability thereof. It is indicated that in the prior art attempts have been made to attach hydrophilic moieties to the plastic surface to overcome this problem (column 1, lines 12 to 45).

Each of the Ambroski patents is directed to a method for rendering wettable the surfaces of hydrophobic polymeric films which tend to produce fogging in moist atmospheres, which is deleterious in materials desired to be transparent. (See Amborski 3,274,090, Column 1, second paragraph.) While of little significance in the rejection, it should be noted that the Amborski patents are not limited to wrapping materials, as argued, but also include other applications of plastic films, such as in solar stills.

In view of the above teachings, we disagree with appellants' arguments and consider the references to be properly combinable since each attempts to overcome the same problem, which is the wettability of hydrophobic plastic surfaces. Whether in the form of a contact lens or a flat sheet (useful as wrapping material), each desires to overcome the fogging of a transparent plastic surface. Hence the expedients taught in the Amborski patents are obviously applicable in the solving of the problem indicated in Szekely et al., which is fundamentally the same.

The Ambroski patents disclose exposure of hydrophobic plastic surfaces to the reaction of a gaseous atmosphere containing the vapors of such compounds as dimethyl formamide or acrylic acid in the presence of an electrical discharge. This is substantially that which appellants are claiming, and the application of this expendient to a contact lens surface is clearly rendered obvious to one skilled in this art from the combination of references.

We note that appellants have not separately argued the expedients indicated in the dependent claims, and it is apparent that these must be recognized equivalents since they are not individually supported by exemplary disclosure in the specification. For the reasons stated above the Examiner's rejection will be sustained.

The decision of the Examiner is affirmed.

Affirmed

/s/ H. Magil
Examiner-in-Chief

/s/ J. H. J. Lidoff
Examiner-in-Chief

/s/ G. K. Milestone
Examiner-in-Chief
(*Acting*)
Board of Appeals

APPENDIX C.

Note: This opinion will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN THE MATTER OF THE APPLICATION OF HYMIE D. GESSER AND ROBERT E. WARRINER	Patent Appeal No. 9170. Serial No. 29,635.

Decided: March 21, 1974

MARKEY, *Chief Judge.*

DECISION

The decision of the board of appeals is *affirmed.*

OPINION

We find no reversible error below.

Szekely and Amborski are properly combinable as references. Both contemporaneously taught processes for rendering hydrophobic plastics hydrophilic or wettable. Szekely describes a polyvinyl alcohol solution which can be applied to contact lenses to render them hydrophilic. Amborski taught a process

of attacking the hydrophobic surface of plastic films with polar-functional-group-forming radicals to make the surface wettable or hydrophilic.

Szekely taught that the solution to the problem of irritating, fogging, plastic lenses lay in making them wettable or hydrophilic.

Appellants' independent claim is to the Amborski process applied to lenses in place of the Szekely process. The radical sources of claims 2-9 and the lens materials of claims 10 and 11 are recognized in appellants' specification as previously well known.

Appellants argue that Amborski says nothing about contact lenses, or about the lens materials of claims 10 and 11. With such disclosures, Amborski would have been an anticipation. But Amborski is cited (with Szekely), under 35 USC 103 as rendering the claims obvious, not as an anticipation.

Appellants also argue that some of Amborski's gases might have made lenses treated therewith harmful to the eye. We note, however, that among the "treating agent" gases listed by Amborski is dimethyl formamide which is encompassed within appellants' claims and which bears a relationship to the "organic amides" listed by appellants. There is no evidence of record in support of appellants' arguments in their brief regarding the gases of Amborski. In the absence of contrary evidence, it must be presumed that those skilled in the art of contact lenses would select the harmless gases from among those listed by Amborski.

Contrary to appellants' arguments regarding a "new use," they employ the Amborski process for an old use, i.e., to make a plastic wettable. That the old use is applied to a different plastic or a different product is of no moment where, as here, neither the process nor the result is changed. It was an obvious use of Amborski's plastic film wetting process to treat plastic contact lenses, in place of Szekely's coating process.

The meaning of "fogging" in the fields of contact lenses and wrapping materials was apparently not argued below and is not, therefore, before us. In any event, the cure for fogging, however caused, is the same, i.e., making the plastic wettable.